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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,628	03/30/2001	Jonathan R. Cohen	60231-300104	9482
21912	7590	01/30/2004	EXAMINER	
VAN PELT & YI LLP 10050 N. FOOTHILL BLVD #200 CUPERTINO, CA 95014			AWAD, AMR A	
			ART UNIT	PAPER NUMBER
			2675	

DATE MAILED: 01/30/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/823,628

Applicant(s)
Cohen et al.

Examiner
Amr Awad

Art Unit
2675



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 28, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above, claim(s) 24-36 and 49-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 37-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

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DETAILED ACTION

Information Disclosure Statement

1. The references cited in the Information Disclosure Statements filed October 11, 2002 have been considered by the Examiner; see attached PTO-1449.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 1-23 and 37-48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,262,711 (Pat_711). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application and the claims of Pat_711 are substantially similar to each other and the minor differences between the claims would be obvious to a person of ordinary skill in the art. For example, by comparing claim of the present application and claim 1 of Pat_711, we can see that the limitation “an interface responsive to an interactor..” in claim 1 of the present application is exactly the same as the interface responsive to an interactor in Pat_711. The limitation “computer system coupled to said interface and operative to process said interactor..” is exactly the same in both claims. The only difference between the two claims is that claim 1 of Pat_711 includes the limitation of having the detection space includes slanted surfaces. However, having a slanted surface to place the physical interactor would be obvious to a person of ordinary skill in the art at the time the invention was made because such slanted surfaces would facilitate placing the physical interactor on the detection space. Similarly with respect to independent claims 14 and 37 of the present application and claim 17 of Pat_711, we can see that the claims are also substantially similar.

Claim Rejections - 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1-9, 14-16, 19 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohara et al (US patent NO. 5,739,814; hereinafter referred to as Ohara).

As to claim 1, Ohara (figure 1) teaches a computerized interactor system (an electronic book) that includes an inclined detection space including a channel having slanted surface for supporting at least one physical interactor which can be manually placed within the detection space and removed from the detection space (for that Ohara (figures 7 and 8) teaches an electronic book (6) composed of a number of stacked sheets (44) which can printed in their surfaces, graphic images, text and codes. Terminals (42) can be connected to each page of the sheet (44). User can touch sensitized areas that are positioned across the sheet, and the signal created by the user's touch is applied to an audio/visual electronic device for entertainment, learning and the like); see column 6, line 61 through column 7, line 42, and also figure 9.

As seen in figure 9, Ohara teaches an interface (connectors (10) and input sensor circuit responsive to the interactor (electronic book 6) in the detection space (sheet 44) and operative to provide an interactor signal indicative of the identity and the status of the interactor; see column 7, lines 44-61. Ohara (figure 1) also teaches a computer system (computer 2 with a CRT monitor 4) coupled to the interface (via connections 10 & 12) and operative to process the interactor

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signal to create a control input (video and audio signal as seen in figure 9) that is indicative of the identity and status of the interactor within a predetermined semantic frame; see column 4, lines 17-46.

As to 14, method claim 14 corresponds to apparatus claim 1 and is analyzed as previously discussed with respect to apparatus claim 1.

As to claims 2 and 9, as can be seen from figure 9, Ohara teaches that the interactor system is connected to application system coupled to the computer system and responsive to the control input (for that Ohara teaches that the interactor system is connected to LCD display (47) and a speaker (20), so that the computer system can display the information in both audio and visual manner; see abstract.

As to claim 3, as seen from figures 5-8, Ohara shows a plurality of sheets which includes a plurality of sensitized touch areas that are positioned across the sheets and can be activated by special pen or the user's finger (plurality of interactors manually put into and removed from the detection space).

As to claim 4, the claim language is broad enough that it can be interpreted as the interactor system can be used by more than one user simultaneously. As can be seen and known that the electronic book in Ohara's device can be used by more than one user at the same time.

As to claims 5-6, Ohara (figure 9) teaches an interactor (pen 24) with an identification circuitry (input sensor circuitry 37), the internal circuitry of the detection space is the sensitized touch areas that are position across the sheet. The identification circuitry of the interactor (37) is

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being connected with the internal circuitry of the detection space (the sensitized touch area); see column 7, lines 11-18.

As to claim 7, Ohara teaches that the channel is a plurality of V-shaped channels (as can be seen from figures 7-8, the plurality of the sheets of the electronic book has V-shape). Since each sheet of the electronic book has a plurality of touch sensitive areas, the interactor (user's finger or special pen) can be positioned in a plurality of positions.

As to claim 8, the claim is broad enough that Ohara's pen (24) or the user's finger (36) is the at least one physical interactor comprises visual feature (the shape of the pen or the fingertip) for metaphorically representing said identity of said interactor.

As to claim 15, Ohara teaches that touching one of the electronic book's sheet in a selected position will result having a different audio or video output (see figure 9).

As to claim 16, the claim is broad enough to read such that "determining the identification of said member" as the pen (stylus) or the finger touching the sensitized touch area is recognized by the input sensor circuit (37) in figure 9.

As to claim 19, as can be seen from both figures 7-8, has a plurality of sheets (44) , and the plurality of sheets can be touched by stylus or fingertip. Therefore, a plurality of physical and identifiable members within the detection space can be placed and determining the semantic meanings of the plurality of members.

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As to claim 21, Ohara (figure 9) teaches having control input (input sensor 37) indicative of the semantic meaning of the member, and wherein an LCD display (47) and speaker (20) is connected to the device for outputting audio and video output.

Claim Rejections - 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 10-12, 20, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohara in view of Montlick (US patent NO. 5,561,446).

Note the discussion of Ohara above. Ohara does not expressly teach that the interactor device is including a network workstations each accessed to the detection wherein the application system includes audio application system and videotape application system includes videotape application system means for marking events in videotape.

Montlick (figure 1) teaches an apparatus for wireless remote information retrieval and pen-based data entry. Montlick teaches a plurality of input devices (12, 14 and 16) (interactor system) to communicating to one another through central computer system via wireless network; see abstract. The system includes audio and video capability (via CD ROM); see column 4, line 58 through column 5, line 20.

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ohara's device to include the device in a network that includes audio and video capability so as to increase the versatility of the device.

8. Claims 13, 17-18 and 37-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohara in view of Allard et al (US patent NO. 5,815,142; hereinafter referred to as Allard).

As to claims 13, 17-18, note the discussion of Ohara above. Ohara does not teach that the interface is operative to detect a position of the interactor placed in the detection space and a time period of when the interactor has been placed in the detection space thereby to provide the interactor signal indicative of the status of the interactor.

Allard (figure 1) teaches a personal communication device that includes a touch screen (10), stylus (22). to be able to efficiently retrieve particular data being displayed, the user touches the desired text with the stylus, the user would continue to touch the same position for a short period of time (for example 0.5 to 1.0 second). At the end of which time the system changes a cursor mark mode; see column 1, line 57 through column 2, line 25.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ohara's device to includes the teaching of Allard to measure the time period of when the interactor has been place in the detection area (the display being touches by the stylus) so as motivated by Allard, using this time period as a signal to the system to retrieve displayed information for use in any one of number of applications as well as the ability of

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marking text from received messages and previously stored data; see abstract and column 2, lines 26-35.

As to claims 37 and 42, Ohara (figure 1) teaches a method for making events (an electronic book) that includes an inclined detection space including a channel having slanted surface for supporting at least one physical interactor which can be manually placed within the detection space and removed from the detection space (for that Ohara (figures 7 and 8) teaches an electronic book (6) composed of a number of stacked sheets (44) which can printed in their surfaces, graphic images, text and codes. Terminals (42) can be connected to each page of the sheet (44). User can touch sensitized areas that are positioned across the sheet, and the signal created by the user's touch is applied to an audio/visual electronic device for entertainment, learning and the like); see column 6, line 61 through column 7, line 42, and also figure 9.

As seen in figure 9, Ohara teaches an interface (connectors (10) and input sensor circuit responsive to the interactor (electronic book 6) in the detection space (sheet 44) and operative to provide an interactor signal indicative of the identity and the status of the interactor; see column 7, lines 44-61. Ohara (figure 1) also teaches a computer system (computer 2 with a CRT monitor 4) coupled to the interface (via connections 10 & 12) and operative to process the interactor signal to create a control input (video and audio signal as seen in figure 9) that is indicative of the identity and status of the interactor within a predetermined semantic frame; see column 4, lines 17-46.

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However, Ohara does not teach that the marking events is within temporal flow by monitoring the time of the input device (stylus) touching the detection space.

Allard (figure 1) teaches a personal communication device that includes a touch screen (10), stylus (22). to be able to efficiently retrieve particular data being displayed, the user touches the desired text with the stylus, the user would continue to touch the same position for a short period of time (for example 0.5 to 1.0 second). At the end of which time the system changes a cursor mark mode; see column 1, line 57 through column 2, line 25.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ohara's device to includes the teaching of Allard to measure the time period of when the interactor has been place in the detection area (the display being touches by the stylus) so as motivated by Allard, using this time period as a signal to the system to retrieve displayed information for use in any one of number of applications as well as the ability of marking text from received messages and previously stored data; see abstract and column 2, lines 26-35.

As to claim 38, as can be seen and known that the electronic book in Ohara's device can be used by more than one user at the same time.

As to claim 39, as seen from figures 5-8, Ohara shows a plurality of sheets which includes a plurality of sensitized touch areas that are positioned across the sheets and can be activated by special pen or the user's finger (plurality of interactors manually put into and removed from the detection space).

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As to claim 40, as can be seen from figure 9, Ohara teaches that touching a selected position in the sheet of the electronic book for different video and audio output.

As to claim 41, as discussed above that only stylus or user's fingertip can be identified by the input sensor circuit (37) in Ohara's invention; see figure 9.

As to claim 43, claim 43 basically is claims 44, 41 and 42 combined and is analyzed as previously discussed with respect to claims 40-42.

As to claims 44-48, the limitations claimed in claims 44-48 are substantially similar to the limitations claimed in claims 37-43 and are analyzed as previously discussed with regard to claims 37-43.

Conclusion

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).*

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amr Awad whose telephone number is (703) 308-8485. The examiner can normally be reached on Monday--Friday from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Saras, can be reached on (703) 305-9720.

A handwritten signature in cursive script, appearing to read "Amr A. Awad".

Amr A. Awad

Primary Patent Examiner

January 24, 2004.